Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte KIYOYUKI NAKAGAWA, KENICHI FUKUDA and ISAMU UTSUNOMIYA

Appeal No. 2002-1626
Application No. 09/287,135

HEARD: February 13, 2003

Before COHEN, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7, 8 and 16 to 19. Claims 1 to 6 and 9 to 15 have been allowed. No claim has been canceled.

We REVERSE.

BACKGROUND

The appellants' invention relates to a feeder and feeding technique for feeding a plurality of randomly oriented electronic chip components in an aligned state (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 7, 8 and 16 to 19 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.[1]

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 17, mailed January 29, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15, filed December 17, 2001) and reply brief (Paper No. 18, filed February 27, 2002) for the appellants' arguments thereagainst.

[1] The two prior art rejections set forth in the final rejection were withdrawn by the examiner in the answer.

OPINION

Initially we note that the examiner's drawing objection raised in the final rejection relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the drawing objection issue raised by the appellants on pages 5-6 of the brief.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain the rejection of claims 7, 8 and 16 to 19 for the reasons which follow.

The claims at issue

Claims 7, 8 and 16 to 19 read as follows:

7. The feeder according to claim 4, wherein said mechanism for varying said stroke range continuously adjusts said stroke range depending on the remaining number of electronic chip components in said hopper.

8. The feeder according to claim 4, wherein said stroke range is decreased at least once when a number of remaining electronic chip components in said hopper is reduced to one-fifth or less of the capacity of said hopper.

16. A method for feeding electronic chip components, comprising the steps of:
receiving a plurality of electronic chip components in a hopper of a feeder;
agitating the electronic chip components with an aligning path forming member by moving the aligning path forming member over a stroke range, thereby causing the electronic components to enter a tubular aligning path formed by the aligning path forming member; and

when the number of electronic chip components in said hopper decreases, shortening the stroke range of the aligning path forming member.

17. The method according to claim 16, wherein the step of shortening the stroke range of the aligning path forming member shortens the stroke range when the number of remaining electronic chip components decreases to a predetermined number.

18. The method according to claim 16, wherein the step of shortening the stroke range of the aligning path forming member shortens the stroke range continuously as the number of remaining electronic chip components decreases.

19. The method according to claim 16, wherein the step of shortening the stroke range of the aligning path forming member shortens the stroke range when the number of remaining electronic chip components decreases to about 1/5 of the capacity of the hopper.

The examiner's basis for the written description rejection

The examiner rejected claims 7, 8 and 16 to 19 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.[2] The sole basis for this rejection as set forth on page 5 of the answer was that "[t]he mechanism for varying the stroke range depending on the remaining number

[2] The description requirement exists in the first paragraph of 35 U.S.C. § 112 independent of the enablement (how to make and how to use) requirement. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985); In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971).

of electronic chip components in the hopper is not disclosed in the originally filed specification."

The appellants' position

The appellants argue that the rejection is improper. Specifically, on pages 7-9 of the brief and pages 4-6 of the reply brief the appellants meticulously set forth where the subject matter of claims 7, 8 and 16 to 19 finds written description support in the description of the preferred embodiments section of the original specification (i.e., pages 10-14).

The case law

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those

skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116). A rejection on the description requirement is fully defeated by a specification which describes the invention in the same terms as the claims. See In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974). In addition, an original claim can provide the written description support required by the first paragraph of 35 U.S.C. § 112. See In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397, supplemental opinion, 480 F.2d 879, 879-80, 178 USPQ 149 (CCPA 1973) and In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973).

Our position

We will not sustain the rejection of claims 7, 8 and 16 to 19 under 35 U.S.C. § 112, first paragraph, for the reasons set forth by the appellants in their briefs. Suffice it to say, pages 10-14 of the specification clearly provide the required written description support for the subject matter of claims 7, 8 and 16 to 19. Additionally, claims 7, 8 and

16 to 19 are original unamended claims[3] and accordingly provide their own written description. Id.

The examiner is correct that the disclosure does explicitly disclose any specific means for communicating the detected number of chip components in the hopper to the means for moving the stopper. However, the written description requirement demands no such disclosure since such a means for communicating is not explicitly claimed. Moreover, it would appear to us that the disclosure does implicitly disclose that the detected number of chip components in the hopper is communicated to the means for moving the stopper for controlling movement of the stopper as claimed.[4]

For the reasons set forth above, the decision of the examiner to reject claims 7, 8 and 16 to 19 under 35 U.S.C. § 112, first paragraph, is reversed.

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[3] Claims 7 and 8 both depend from claim 1 which has been amended. However, we fail to see how the amendment to claim 1 would support the rejection of claims 7 and 8 before us in this appeal.

[4] We note that the examiner has not rejected that claims under either (1) the enablement requirement of 35 U.S.C. § 112, first paragraph, or (2) the definiteness requirement of 35 U.S.C. § 112, second paragraph. When one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what structure corresponds to that language. If an applicant fails to set forth an adequate disclosure showing what structure corresponds to the means-plus-function language used in a claim, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.
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CONCLUSION

To summarize, the decision of the examiner to reject claims 7, 8 and 16 to 19 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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